

ESTTA Tracking number: **ESTTA512838**

Filing date: **12/21/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ORACLE AMERICA, INC.
Granted to Date of previous extension	12/23/2012
Address	500 ORACLE PARKWAY REDWOOD SHORES, CA 94065 UNITED STATES
Correspondence information	Larry H. Tronco Holland & Hart LLP One Boulder Plaza 1800 Broadway St., Ste. 300 Boulder, CO 80302 UNITED STATES ltronco@hollandhart.com, abmiller@hollandhart.com, docket@hollandhart.com Phone:(303) 473-2700

Applicant Information

Application No	85531119	Publication date	06/26/2012
Opposition Filing Date	12/21/2012	Opposition Period Ends	12/23/2012
Applicant	Jefferson Audio Video Systems, Inc. 13020 Middletown Industrial Blvd. Louisville, KY 40223 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Video wrist monitor connected to a video camera; assistive listening devices not for medical purposes, namely, headphones, microphones, transmitters and receivers; computer servers; Internet Protocol video encoders; electrical cables; speaker distribution boxes to distribute audio input to multiple speakers

Applicant Information

Application No	85531110	Publication date	07/10/2012
Opposition Filing Date	12/21/2012	Opposition Period Ends	
Applicant	Jefferson Audio Video Systems, Inc. 13020 Middletown Industrial Blvd. Louisville, KY 40223 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 1981/07/01 First Use In Commerce: 1981/07/01

All goods and services in the class are opposed, namely: Audio and video processors; cameras; microphones; amplifiers; touchscreen monitors; digital audio/video recorders; personal computers; digital signage; electrical power strips; electrical power transformers; audio and video distribution amplifiers; electrical control boxes with system control buttons; transcription devices, namely, a foot pedal that controls computer software for the transcription of audio and video recordings; computer software for controlling the operation of audio and video devices; computer software for publishing audio recordings and video recordings to other media; computer software for scheduling audio recording sessions and video recording sessions; computer software for searching and locating audio and video recordings stored on a database; computer software to view audio recordings and video recordings; enterprise software for controlling and managing the storage and retrieval of audio and video recordings on a computer server; computer software for transcribing audio recordings and video recordings


Grounds for Opposition


False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2178784	Application Date	02/07/1995
Registration Date	08/04/1998	Foreign Priority Date	NONE
Word Mark	JAVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/01/00 First Use In Commerce: 1996/01/00 computer programs for use in developing and executing other computer programs on computers, computer networks, and global communications networks, and instruction manuals sold therewith; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks and global communications networks, and instruction manuals sold therewith		

U.S. Registration No.	1516265	Application Date	04/14/1988
Registration Date	12/13/1988	Foreign Priority Date	NONE
Word Mark	JAVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/09/24 First Use In Commerce: 1987/12/10 COMPUTER PROGRAMS AND USER MANUALS SOLD AS A UNIT FOR USE IN MEASUREMENT AND ANALYSIS OF VIDEO IMAGES FROM COMPOSITE VIDEO SOURCES AND PRE-DIGITIZED FORMATS IN THE FIELD OF SCIENCE, ENGINEERING AND INDUSTRIAL RESEARCH		


U.S. Registration No.	2921013	Application Date	09/13/2000
Registration Date	01/25/2005	Foreign Priority Date	NONE
Word Mark	JAVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1997/04/02 First Use In Commerce: 1997/05/06 Computer hardware, namely, computers, hand-held computers, monitors, servers, [mouse pads, printers and printer peripherals, printed circuit boards containing electrical components and sockets; digital cameras; personal digital assistants; smart cards; smart card readers; telephones; wireless data communications hardware]		

U.S. Registration No.	2298389	Application Date	03/23/1995
Registration Date	12/07/1999	Foreign Priority Date	NONE
Word Mark	JAVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1999/08/04 First Use In Commerce: 1999/08/04 electronic transmission of data over a global communication network		

U.S. Registration No.	2501545	Application Date	02/14/2000
Registration Date	10/30/2001	Foreign Priority Date	NONE
Word Mark	JAVA COMMUNITY PROCESS		

Design Mark	JAVA COMMUNITY PROCESS
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1998/12/00 First Use In Commerce: 1999/06/00 information technology development and consulting services and software development and consulting services

U.S. Registration No.	2582470	Application Date	09/25/1995
Registration Date	06/18/2002	Foreign Priority Date	NONE
Word Mark	JAVA COMPATIBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/05/23 First Use In Commerce: 2000/05/23 computer software for use in connection with computer networks, and global communications networks and instruction manuals sold as a unit therewith		

U.S. Registration No.	2277260	Application Date	10/29/1997
Registration Date	09/14/1999	Foreign Priority Date	NONE
Word Mark	JAVA COMPATIBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/03/00 First Use In Commerce: 1996/03/00 computer programs for use in developing, compiling and executing other computer programs on computers, computer networks, and global communications networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks, and global communications networks; and computer operating systems programs		


U.S. Registration No.	2137780	Application Date	02/20/1996
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Registration Date	02/17/1998	Foreign Priority Date	NONE
Word Mark	JAVAONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/05/00 First Use In Commerce: 1996/05/00 arranging and conducting trade shows in the fields of computer and information technology Class 041. First use: First Use: 1996/05/00 First Use In Commerce: 1996/05/00 arranging and conducting educational conferences		

U.S. Registration No.	2416017	Application Date	12/01/1995
Registration Date	12/26/2000	Foreign Priority Date	NONE
Word Mark	JAVASCRIPT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/06/00 First Use In Commerce: 1996/06/00 computer programs, namely, utility programs, language processors and interpreters Class 042. First use: First Use: 1996/06/00 First Use In Commerce: 1996/06/00 providing computer programs, namely, utility programs, language processors and interpreters, that may be downloaded from a global computer network		

U.S. Registration No.	2304483	Application Date	10/09/1996
Registration Date	12/28/1999	Foreign Priority Date	NONE
Word Mark	JAVABEANS		
Design Mark	<div style="text-align: center;">JAVABEANS</div>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/04/20 First Use In Commerce: 1998/04/20 Computer programs for use in developing and executing other computer programs on computers, computer networks, and global communications networks; computer programs for use in viewing other computer programs on computers, computer networks and global communications networks		

U.S. Registration No.	4210254	Application Date	11/06/2007
Registration Date	09/18/2012	Foreign Priority Date	NONE
Word Mark	JAVAFX		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2008/12/04 First Use In Commerce: 2008/12/04 computer programs for use in computer networking; computer programs for use in computer emulation; computer programs for creating graphical interfaces; computer programs for use in the development of computer programs, programming languages, toolkits and compilers; computer programs for use in developing, compiling and executing other computer programs on computers, computer networks, and global communications networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks and global communications networks; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sound, video, images, graphics, and/or data; computer operating system programs; computer utility programs; computer programs for use with computer servers; and instructional manuals in electronic format sold with the aforementioned goods</p> <p>Class 041. First use: First Use: 2008/12/04 First Use In Commerce: 2008/12/04 Education services, namely, providing classes, workshops and seminars in the fields of computers, computer software, computer networks, information technology, and global computer network technology, and related services; providing of training in the fields of computers, computer software, computer networks, information technology, and global computer network technology, and related services</p> <p>Class 042. First use: First Use: 2008/12/04 First Use In Commerce: 2008/12/04 Technical consultation in the technology fields of computer software, computer networks, and global communication networks; computer consultation services; design and development of computer software; computer programming; providing online information and news in the field of computer software and information technology</p>

U.S. Registration No.	3681468	Application Date	11/01/2004
Registration Date	09/08/2009	Foreign Priority Date	NONE
Word Mark	JAVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2009/06/08 First Use In Commerce: 2009/06/08		

	Computer peripherals; television set top boxes; compact disc players; internet television hardware, namely, digital television receivers, programmable digital television recorders, and television decoders; television sets
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Attachments	76128471#TMSN.gif (1 page)(bytes) 74650573#TMSN.gif (1 page)(bytes) 75918269#TMSN.gif (1 page)(bytes) 75383820#TMSN.jpeg (1 page)(bytes) 75179857#TMSN.gif (1 page)(bytes) 77322393#TMSN.jpeg (1 page)(bytes) 78509488#TMSN.jpeg (1 page)(bytes) Notice of Opposition - JAVS.pdf (6 pages)(84647 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Larry H. Tronco/
Name	Larry H. Tronco
Date	12/21/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ORACLE AMERICA, INC.,)	
)	Opposition No.
Opposer,)	
)	
v.)	Mark: JAVS
)	
Jefferson Audio Video Systems, Inc.)	
)	Serial No. 85/531,119
Applicant.)	Serial No. 85/531,110
)	

NOTICE OF OPPOSITION

Oracle America, Inc. (“Opposer”), a Delaware corporation, having a principal place of business at 500 Oracle Parkway, Redwood Shores, California 94065, believes it will be damaged by registration of the mark JAVS shown in U.S. Trademark Applications Serial Nos. 85/531,119 and 85/531,110 (the “Applications”), filed by the Applicant on February 1, 2012, for “video wrist monitor connected to a video camera; assistive listening devices not for medical purposes, namely, headphones, microphones, transmitters and receivers; computer servers; Internet Protocol video encoders; electrical cables; speaker distribution boxes to distribute audio input to multiple speakers” in Class 9, and “audio and video processors; cameras; microphones; amplifiers; touchscreen monitors; digital audio/video recorders; personal computers; digital signage; electrical power strips; electrical power transformers; audio and video distribution amplifiers; electrical control boxes with system control buttons; transcription devices, namely, a foot pedal that controls computer software for the transcription of audio and video recordings; computer software for controlling the operation of audio and video devices; computer software for publishing audio recordings and video recordings to other media; computer software for scheduling audio recording sessions and video recording sessions; computer software for

searching and locating audio and video recordings stored on a database; computer software to view audio recordings and video recordings; enterprise software for controlling and managing the storage and retrieval of audio and video recordings on a computer server; computer software for transcribing audio recordings and video recordings” also in Class 9 and hereby opposes the Applications. As grounds for its opposition, Opposer alleges that, upon actual knowledge with respect to itself and its own actions, and upon information and belief as to other matters:

1. Since at least as early as January 1996, Opposer adopted and began using JAVA as a mark in connection with computer and technology-related services. Opposer’s JAVA products and services represent a technological breakthrough, which enables computers with previously incompatible operating systems to communicate with each other, i.e. operate together. Opposer’s JAVA technology has proven enormously popular, creating a virtual overnight sensation in the computing field. In addition to the JAVA mark, Opposer has adopted and uses numerous JAVA-based marks (“JAVA Marks”) in connection with computer hardware and software products, internet related products and services, and mobile devices (“JAVA Technologies”). Since its first use in 1996, the JAVA mark has now appeared on billions of computer screens and mobile communication devices throughout the world.

2. All of Opposer’s JAVA-based registrations were filed and/or registered on the Principal Register prior to the date Applicant filed its applications for the JAVS mark. The following registered marks of Opposer are valid, subsisting and incontestable by operation of law: Reg. Nos 2,178,784; 1,516,265; 2,921,013; 2,298,389; 2,501,545; 2,582,470; 2,277,260; 2,137,780; 2,416,017; 2,304,483; 4,210,254; and 3,681,468. They are prima facie evidence of Opposer’s exclusive right to use its marks in commerce in connection with the goods and services specified in Oracle’s federal registrations.

3. As a consequence of Opposer's extensive use, promotion, licensing and distribution activity in interstate commerce, the JAVA Marks have become well known in the computer and technology industry and beyond, identifying Opposer as the exclusive provider of the JAVA Technologies. As a result, Opposer's family of JAVA Marks has become an invaluable asset of Opposer and a principal symbol of its goodwill and reputation.

COUNT I
(Likelihood of Confusion)
15 U.S.C. § 1052(d)

4. Since well before the filing date of the Applications, Opposer and its predecessors have used the JAVA Marks in connection with computer-related goods and services. Indeed, Opposer's first registration for JAVA issued more than fifteen (15) years before the filing date of the Applications.

5. Applicant's JAVS mark so resembles Opposer's prior used and registered JAVA Marks as to be likely, when used in connection with the goods and services set forth in the Applications, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT II
(False Designation of Origin)
15 U.S.C. § 1052(a)

6. Opposer's JAVA Marks convey to consumers the source of Opposer's high quality and well-known goods and services.

7. In view of the similarity of the respective marks, the related nature of the goods and services of the respective parties, and the well-known nature of Opposer's JAVA Marks,

Applicant's registration of the JAVS mark, which so closely resembles Opposer's JAVA Marks, would falsely suggest a connection between Applicant and Opposer.

8. Applicant is not connected with or otherwise affiliated with Opposer and registration should be refused pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

COUNT III
(Likelihood of Dilution)
15 U.S.C. § 1125(c)

9. Opposer's JAVA Marks have become well-known and famous as a designation of Opposer's goods and services.

10. Opposer's JAVA Marks became famous well before the filing date of the Applications.

11. Applicant's JAVS mark so resembles Opposer's prior used and registered JAVA Marks as to dilute the distinctive quality of Opposer's marks under Section 43(c) of the Lanham Act, as amended, 15 U.S.C. 1125(c).

WHEREFORE, Opposer believes that it will be damaged by registration of the mark shown in Applications Serial Nos. 85/531,119 and 85/531,110 and respectfully requests that the opposition be sustained, and that the registration to Applicant be refused.

Dated this 21st day of December, 2012.

Respectfully submitted

/Larry H. Tronco/

Larry H. Tronco

Anna B. Miller

HOLLAND & HART LLP

One Boulder Plaza
1800 Broadway, Suite 300
Boulder, CO 80302
Phone: 303-473-2792
Fax: 303-473-2720

Attorneys for Opposer

Oracle America, Inc.

CERTIFICATE OF SERVICE

I certify that on December 21, 2012 I served a copy of the above **NOTICE OF OPPOSITION** to the following by U.S. Mail, postage prepaid:

Monica L. Dias
Frost Brown Todd LLC
3300 Great American Twr 301 E 4th St
Cincinnati, Ohio 45202

/Anna B. Miller/

Anna B. Miller